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CROMPTON SEAGER TUFTE

6123599349 P.14

Appl. No. 10/027,039
Amendment dated August 20, 2004
Reply to Office Action dated June 29, 2004

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Official Action of the Examiner mailed June 29, 2004, setting a three-month shortened statutory period for response ending September 29, 2004. Claims 1-19, 22-23, and 25-34 remain pending. Reconsideration, examination and allowance of all pending claims are respectfully requested.

On page 2 of the Office Action, the Examiner rejected claims 1-4, 13, 14, 18 and 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1 and 13, the Examiner states that the preambles do not indicate that a measurement is compensated for.

During a telephone interview with the Examiner on August 12, 2004, the Examiner indicated that the phrase "a method for compensating" (Emphasis Added) was not clear given the remaining elements of the claim. That Examiner stated that it was not clear what was being compensated for. Although Applicants respectfully disagree, Applicants have amended claim 1 to recite "a method of obtaining a measure of the thermal conductivity", and also rearranged some of the other language in the preamble to be consistent therewith. Similar amendments were made to claim 13. In view thereof, claims 1 and 13 are believed to fully comply with 35 U.S.C. § 112, second paragraph. For similar and other reasons, dependent claims 2-4, 14, 18 and 19 are also believed to fully comply with 35 U.S.C. § 112, second paragraph.

Also on page 2 of the Office Action, the Examiner rejected claims 5-8, 15-17, 23, 25 and 26 under 35 U.S.C. § 102(b) as being anticipated by Bohrer (U.S. Patent No. 4,478,076).

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Regarding claims 5 and 15, the Examiner states that Bohrer suggests a sensing apparatus comprising: a thin film heater (26); a thin film thermal or temperature sensor (22 & 24) in proximate position to the heater; a semiconductor body (20) with a depression (30) therein; and an energizing means (46) connected to the heater for energizing the heater (citing column 3, line 21 through column 5, line 67). The Examiner further states that Bohrer suggests that the changing temperatures of sensors 22 and 24 are sensed as changes in resistance. The Examiner states that circuits for accomplishing these functions are illustrated in Figures 4 and 5 of Bohrer.

On page 3 of the Office Action, the Examiner states that when the structure recited in a reference is substantially identical to that of the claims, claimed properties of functions are presumed to be inherent (citing MPEP § 2112.02). The Examiner states that courts have held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. The Examiner also states that the courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function.

After careful review, Applicants must respectfully disagree. Claim 5 recites, among other things, energizing means connected to said heater for energizing the heater to induce an elevated temperature condition in said thermal sensor, wherein said elevated temperature condition is selected to reduce the effect of at least one of the components in the fluid of interest on the selected property that is measured by the measuring means. As can readily be seen, the

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energizing means of claim 5 is expressed in means-plus-function format, which is explicitly authorized by 35 U.S.C. § 112, ¶ 6. 35 U.S.C. § 112, ¶ 6 states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such a claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

In view thereof, Applicants do not believe it is proper for the Examiner to assign no patentable weight to the "energizing means" recited in claim 5. Bohrer certainly does not disclose an "energizing means connected to said heater for energizing the heater to induce an elevated temperature condition in said thermal sensor, wherein said elevated temperature condition is selected to reduce the effect of at least one of the components in the fluid of interest on the selected property that is measured by the measuring means", as recited in claim 5. As such, and for these and other reasons, claim 5 is believed to be clearly patentable over Bohrer. For similar and other reasons, dependent claims 6-8, 23, and 25-26 are also believed to be clearly patentable over Bohrer.

During the above-mentioned telephone interview of August 12, 2004, the Examiner indicated that it would be more clear if the format of claim 5 were amended so that the "wherein ... " clause were moved into the same paragraph as the "energizing means" clause. Claim 5 has been amended to comply with the Examiner's request.

Claim 15 recites, among other things, an energizer coupled to said heater, wherein said energizer provides a control signal to said heater to induce a predetermined temperature proximate to the heater, wherein said temperature is preselected to reduce the effect of H₂O.

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Although claim 15 is not a means-plus-function claim, it is clear that Bohrer does not disclose a product that is identical or substantially identical in structure or composition, as suggested by the Examiner. As noted above, claim 15 recites an energizer (which is structure) which provides "a control signal to said heater to induce a predetermined temperature proximate to the heater, wherein said temperature is preselected to reduce the effect of H₂O." Nothing in Bohrer discloses such an energizer. MPEP 2112.01, which was cited by the Examiner in the Office Action, states that:

Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 562 F.2d at 1255, 195 USPQ at 433.

(Emphasis in original). Clearly, Bohrer does not disclose an energizer that provides "a control signal to said heater to induce a predetermined temperature proximate to the heater, wherein said temperature is preselected to reduce the effect of H₂O", as recited in claim 15, and thus does not necessarily possess the characteristics of the claimed invention. For these reasons, as well as other reasons, claim 15 is believed to be clearly patentable over Bohrer. For similar and other reasons, dependent claims 16-17 are also believed to be clearly patentable over Bohrer.

On page 4 of the Office Action, the Examiner indicated that claims 9-12, 18, 19, 22 and 27-343 are allowed. The Examiner also indicated that claims 1-4, 13, 14, 18 and 19 would be allowable if rewritten or amended to overcome the rejections(s) under 35 U.S.C. § 112, second paragraph. Since the claims 1-4, 13, 14, 18 and 19 are now believed to fully comply with 35 U.S.C. § 112, second paragraph, claims 1-4, 13, 14, 18 and 19 are believed to be in condition for allowance.

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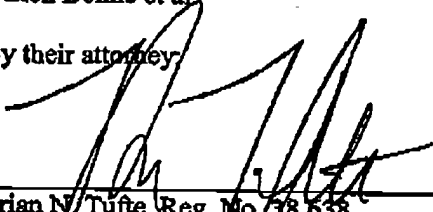
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In view of the foregoing, all pending claims 1-19, 22-23, and 25-34 are believed to be in condition for allowance. Reexamination and reconsideration are respectfully requested. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-677-9050.

Respectfully Submitted,

Ulrich Bonne et al

By their attorney

Date: August 20, 2004

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